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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,831	07/11/2001	Thomas J. Maginot	22220-06167	1578
758 7590 01/15/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 01/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/903,831

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebilic

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/26/06, 8/7/06</u> | 6) <input type="checkbox"/> Other: _____ |

The indicated allowability of claims 425, 432 and 435 is withdrawn in view of a more careful reading of Piplani et al (US 5,489,295) and the claims themselves.

Information Disclosure Statement

The information disclosure statement filed August 7, 2006 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. It was filed after the action on the merits dated June 7, 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 75-78, 94, 96, 98, 101, 102, 104-107, 109, 137-139, 146, 148, 153, 156, 157, 159-162, 166, 428, 431, 432, and 435 are rejected under 35 U.S.C. 102(e) as being anticipated by Piplani et al (US 5,489,295). Piplani anticipates the claim language where the locating step is not specifically disclosed thereby but inherent thereto because the graft is shown within the delivery device in Figures 9 to 19. For a brief moment, during insertion of the graft of Piplani, part of the arms (legs) thereof will be within the first artery (223) and part of the arms (legs) will be sticking out of the artery (223) through the opening (226). The second position will be upon release of the

attachment means (126) within the blood vessel; see Figures 12 and 15. The arms as claimed are met by the legs or struts of a Piplani as attachment means (126), the alignment step as claimed is performed in Figures 9 and 10 of Piplani where the graft is inserted into the hole (226). The attachment means self-expands so the claimed spring action or resiliency is met; see column 9, lines 7-12. The terminology "about" is interpreted broadly as encompassing "around" or "near" not necessarily "over." The terminology "extravascularly" aligning and locating the flange portion inherently occurs in Piplani as the graft thereof is aligned and advanced through the arteriotomy; note what occurs between the steps shown in Figures 9 and 10.

Regarding claims 109 and 153, some additional advancing of the graft is not precluded by the present claim language such that the claimed method is reads on what is disclosed by Piplani.

Regarding claim 432, the aortotomy as claimed is met by the natural opening from the abdominal aorta (222) to the left iliac artery (223).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 425 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaster et al (US 4,366,462) in view of Donaldson (US 2,935,068). Kaster teaches end-to-side anastomosis with arms (fingers (26)) and a flange (band (46)). But Kaster discloses the

method of blood vessel by-pass in general and not for the use on an aorta; see Figures. However, Donaldson teaches that it was known to use similar devices to by-pass aortas; see Figure 3 and column 1. Therefore, it is the Examiner's position that it would have been prima facie obvious to utilize the Kaster method and device in a method of aorta by-pass for the same reasons that Donaldson teaches doing the same.

Response to Arguments

Applicant's arguments filed January 24, 2007 have been fully considered but they are not persuasive.

The Applicant argues that Piplani's arteriotomy is used temporarily and not to install a graft. However, the claims only variously recite a "method of locating a graft assembly" "in relation to an arteriotomy" so there is no requirement that the opening is somehow more permanent in the present invention as compared to that of Piplani.

The Applicant also argues that Piplani does not teach disposing the arms thereof about the opening. However, the Examiner disagrees and has merely given the term "about" its broadest reasonable interpretation.

Allowable Subject Matter

Claims 70, 71, 80-82, 84-86, 90-93, 121-123, 125, 127, 129-134, 136, 140, 142, 143, 152, 164, 165, 426-427, 433-434, and 436 are allowable over the prior art of record.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be

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applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774

Continuation of Disposition of Claims: Claims pending in the application are 70,71,75-78,80-82,84-86,90-94,96,98,101,102,104-107,109,121-123,125,127,129-134,136-140,142,143,146,148,152,153,156,157,159-162,164-166,425-428 and 431-436.

Continuation of Disposition of Claims: Claims allowed are 70,71,80-82,84-86,90-93,121-123,125,127,129-134,136,140,142,143,152,164,165,426,427,433,434 and 436.

Continuation of Disposition of Claims: Claims rejected are 75-78,94,96,98,101,102,104-107,109,137-139,146,148,153,156,157,159-162,166,425,428,431,432 and 435.